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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/802,492 | 03/09/2001 | Stephen Belth | 12166-0002 | 7458 |

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| EXAMINER |
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YOUNG, JOHN L

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| ART UNIT | PAPER NUMBER |
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3622

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/802,492

Applicant(s)

BELTH, STEPHEN

Examiner

John L Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies ~~not received~~

JOHN L. YOUNG
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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NON-FINAL ACTION

DRAWINGS

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §101

2. **Rejections Withdrawn.**

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Marsh 5,848,397 (12/08/1998) (herein referred to as ("Marsh").

As per claim 1, Marsh (the ABSTRACT; FIG. 5; FIG. 8; FIG. 1; FIG. 4; col. 1, ll. 20-26; col. 1, ll. 12-19; col. 1, ll. 26-67; col. 3, ll. 4-27; col. 6, ll. 35-50; col. 7, ll. 5-40;

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col. 7, ll. 52-67; col. 15, ll. 20-30) shows: “A marketing system for communicating with an audience including a targeted individual through a communication system. . . . a processor; a database accessible by the processor and including data related to the targeted individual and an identifier; a plurality of audio recordings accessible by the processor; the processor adapted to present the targeted individual with a resource including at least one audio recording selected from the plurality of audio recordings and configured to present the audience with a recording containing marketing information.”

Marsh lacks an explicit recitation of **“the at least one tailored portion including at least one audio recording selected from the plurality of audio recordings configured based on at least a portion of the data in the database related to the targeted individual.”**

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Marsh (col. 7, ll. 52-67; col. 15, ll. 20-30) shows **“the at least one tailored portion including at least one audio recording selected from the plurality of audio recordings configured based on at least a portion of the data in the database related to the targeted individual. . . .”** because modification of the disclosure of Marsh cited above would have provided means *“for scheduling the distribution, downloading and presentation of a continuously-changing display to computer users. The invention is particularly well-suited to presenting advertisements to*

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users of an electronic mail service. . . . This feature is particularly useful for targeted advertising.” (See March (p. 2, ll. 65-67; and p. 3, ll. 1-27)).

As per claims 2-11, Marsh shows the system of claim 1 and subsequent base claims depending from claim 1.

Marsh (the ABSTRACT; FIG. 5; FIG. 8; FIG. 1; FIG. 4; col. 1, ll. 20-26; col. 1, ll. 12-19; col. 1, ll. 26-67; col. 3, ll. 4-27; col. 6, ll. 35-50; col. 7, ll. 5-40; col. 15, ll. 20-30; and whole document) shows the elements and limitations of claims 2-11.

Marsh lacks explicit recitation of the elements and limitations of claims 2-11.

“Official Notice” is taken that both the concept and the advantages of the elements and limitations of claims 2-11 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious **that the disclosure of Marsh shows the elements of claims 2-11**, because **modification of the disclosure of Marsh cited above** would have provided means *“for scheduling the distribution, downloading and presentation of a continuously-changing display to computer users. The invention is particularly well-suited to presenting advertisements to users of an electronic mail service. . . . This feature is particularly useful for targeted advertising.”* (See March (p. 2, ll. 65-67; and p. 3, ll. 1-27)).

Independent claim 12 is rejected for substantially the same reasons as independent claim 1.

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As per claims 13-20, Marsh shows the system of claim 12 and subsequent base claims depending from claim 12.

Marsh (the ABSTRACT; FIG. 5; FIG. 8; FIG. 1; FIG. 4; col. 1, ll. 20-26; col. 1, ll. 12-19; col. 1, ll. 26-67; col. 3, ll. 4-27; col. 6, ll. 35-50; col. 7, ll. 5-40; col. 15, ll. 20-30; and whole document) shows the elements and limitations of claims 13-20.

Marsh lacks explicit recitation of the elements and limitations of claims 13-20.

"Official Notice" is taken that both the concept and the advantages of the elements and limitations of claims 13-20 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious **that the disclosure of Marsh shows the elements of claims 13-20**, because **modification of the disclosure of Marsh cited above** would have provided means *"for scheduling the distribution, downloading and presentation of a continuously-changing display to computer users. The invention is particularly well-suited to presenting advertisements to users of an electronic mail service. . . . This feature is particularly useful for targeted advertising."* (See March (p. 2, ll. 65-67; and p. 3, ll. 1-27)).

Independent claim 21 is rejected for substantially the same reasons as independent claim 12.

As per claims 22-26, Marsh shows the method of claim 21 and subsequent base claims depending from claim 21.

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Marsh (the ABSTRACT; FIG. 5; FIG. 8; FIG. 1; FIG. 4; col. 1, ll. 20-26; col. 1, ll. 12-19; col. 1, ll. 26-67; col. 3, ll. 4-27; col. 6, ll. 35-50; col. 7, ll. 5-40; col. 15, ll. 20-30; and whole document) shows the elements and limitations of claims 22-26.

Marsh lacks explicit recitation of the elements and limitations of claims 22-26.

"Official Notice" is taken that both the concept and the advantages of the elements and limitations of claims 22-26 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious **that the disclosure of Marsh shows the elements of claims 22-26**, because **modification of the disclosure of Marsh cited above** would have provided means *"for scheduling the distribution, downloading and presentation of a continuously-changing display to computer users. The invention is particularly well-suited to presenting advertisements to users of an electronic mail service. . . . This feature is particularly useful for targeted advertising."* (See March (p. 2, ll. 65-67; and p. 3, ll. 1-27)).

Independent claim 27 is rejected for substantially the same reasons as independent claim 1.

As per claims 28-31, Marsh shows the system of claim 27 and subsequent base claims depending from claim 27.

Marsh (the ABSTRACT; FIG. 5; FIG. 8; FIG. 1; FIG. 4; col. 1, ll. 20-26; col. 1, ll. 12-19; col. 1, ll. 26-67; col. 3, ll. 4-27; col. 6, ll. 35-50; col. 7, ll. 5-40; col. 15, ll. 20-30; and whole document) shows the elements and limitations of claims 28-31.

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Marsh lacks explicit recitation of the elements and limitations of claims 28-31.

"Official Notice" is taken that both the concept and the advantages of the elements and limitations of claims 28-31 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious **that the disclosure of Marsh shows the elements of claims 28-31**, because **modification of the disclosure of Marsh cited above** would have provided means *"for scheduling the distribution, downloading and presentation of a continuously-changing display to computer users. The invention is particularly well-suited to presenting advertisements to users of an electronic mail service. . . . This feature is particularly useful for targeted advertising."* (See March (p. 2, ll. 65-67; and p. 3, ll. 1-27)).

Independent claim 32 is rejected for substantially the same reasons as independent claim 1.

As per claims 33-35, Marsh shows the system of claim 32 and subsequent base claims depending from claim 32.

Marsh (the ABSTRACT; FIG. 5; FIG. 8; FIG. 1; FIG. 4; col. 1, ll. 20-26; col. 1, ll. 12-19; col. 1, ll. 26-67; col. 3, ll. 4-27; col. 6, ll. 35-50; col. 7, ll. 5-40; col. 15, ll. 20-30; and whole document) shows the elements and limitations of claims 33-35.

Marsh lacks explicit recitation of the elements and limitations of claims 33-35.

"Official Notice" is taken that both the concept and the advantages of the elements and limitations of claims 33-35 were well known and expected in the art by one

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of ordinary skill at the time of the invention. It would have been obvious **that the disclosure of Marsh shows the elements of claims 33-35**, because **modification of the disclosure of Marsh cited above** would have provided means *“for scheduling the distribution, downloading and presentation of a continuously-changing display to computer users. The invention is particularly well-suited to presenting advertisements to users of an electronic mail service. . . . This feature is particularly useful for targeted advertising.”* (See March (p. 2, ll. 65-67; and p. 3, ll. 1-27)).

Independent claim 36 is rejected for substantially the same reasons as independent claim 1.

As per claims 37-38, Marsh shows the method of claim 36 and subsequent base claims depending from claim 36.

Marsh (the ABSTRACT; FIG. 5; FIG. 8; FIG. 1; FIG. 4; col. 1, ll. 20-26; col. 1, ll. 12-19; col. 1, ll. 26-67; col. 3, ll. 4-27; col. 6, ll. 35-50; col. 7, ll. 5-40; col. 15, ll. 20-30; and whole document) shows the elements and limitations of claims 37-38.

Marsh lacks explicit recitation of the elements and limitations of claims 37-38.

“Official Notice” is taken that both the concept and the advantages of the elements and limitations of claims 37-38 were well known and expected in the art by one of ordinary skill at the time of the invention. It would have been obvious **that the disclosure of Marsh shows the elements of claims 37-38**, because **modification of the disclosure of Marsh cited above** would have provided means *“for scheduling the*

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distribution, downloading and presentation of a continuously-changing display to computer users. The invention is particularly well-suited to presenting advertisements to users of an electronic mail service. . . . This feature is particularly useful for targeted advertising.” (See March (p. 2, ll. 65-67; and p. 3, ll. 1-27)).

RESPONSE TO ARGUMENTS

4. Applicant's arguments filed 12/27/2004 have been fully considered but they are not persuasive for the following reasons:

Applicant's argument are moot because of new grounds of rejection herein presented.

Furthermore, in response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., “claim 1 provides a tailored advertisement to each targeted individual. . . .”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, Applicant's failure to timely challenge the Official Notice rejections of the prior Office action and the Official Notice evidence is constructively admitted prior art by the Applicant.

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Applicant's argument is silent as to an adequate traversal of Official Notice evidence.

It is well settled that "To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 {{CCPA}} ('[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.'). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate." (See MPEP 2144.03(B)(C) Reliance on Common Knowledge in the Art or "Well Known" Prior Art 8 ed., May 2004, pp. 2100-137 and 2100-138).

In this instance, Applicant's Response fails to demand any reference in support of the Official Notice evidence cited by the Examiner in the prior Office Action for claims 2-11, 13-20, 22-26, 28-31, 33-35 and 37-38. And, Applicant's Response lacks adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the Official Notice and thereby fails to adequately traverse the Official Notice rejections of the instant invention. Therefore, the Official Notice evidence presented in the prior Office Action is deemed admitted and no further references are required to support said Official Notice evidence.

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CONCLUSION

5. Any response to this action should be mailed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801 or (571) 272-6725. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469 or (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

John L. Young

Primary Patent Examiner

JOHN L. YOUNG, ESQ.
PRIMARY EXAMINER

March 16, 2005